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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,355	05/25/2001	Masashi Shiomi	0033-0723P	4566
2292 7590 02/09/2007 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER NGUYEN, NGA B	
			ART UNIT	PAPER NUMBER
			3692	

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	02/09/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 02/09/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

09/864,355

Applicant(s)

SHIOMI ET AL.

Examiner

Nga B. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-35, 40-42, 45-74, 79, and 80 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-35, 40-42, 45-74, 79 and 80 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is the answer to the Amendment filed on October 17, 2006, which paper has been placed of record in the file.
2. Claims 1-3, 6-35, 40-42, 45-74, 79, and 80 are elected for consideration.

Response to Arguments/Amendment

3. Applicant's arguments with respect to claims 1-3, 6-35, 40-42, 45-74, 79, and 80 have been considered but are not persuasive.

In response to the applicant's argument that Fritsch does not disclose "the ID information of sub-application to be utilized next that is stored in the executed sub-application", examiner submits that Fritsch discloses every album or CD has track number and track name (note that each track is equivalent to sub-application in the claimed invention, track number is equivalent to sub-application's ID), see figure 2A, the Louis Armstrong album contains 8 tracks, track number 1 to track number 8, each track assigns a track name or song title, track number 2 is next to track number 1, track number 3 is next to track number 2, etc...Therefore, *Fritsch does teach "the ID information of sub-application to be utilized next that is stored in the executed sub-application".*

In response to the applicant's arguments against the user of Official Notice, examiner submits that applicant has not presented arguments that the features were not well known, why the examiner's examples to support the Office Notice were not well known. Applicant has not submitted any rebuttal of the well-known statements, but has

merely requested references disclosing the well-known limitations. In the paragraph in MPEP 2144.03, reference is made to *In re Ahlert* 421 F.2d 1088, 1091, 165 USPQ 418, 420-421 (CCPA 1970) that "Furthermore, the applicant must be given the opportunity to challenge the correctness of such assertions and allegations." Again, the applicant has not challenged the correctness of the assertions, only the user of Official notice. Bald statements such as "lack of any objective evidence of record supporting the allegation" or "lacks substantial evidence support and must be considered merely the opinion of the examiner", are not adequate and do not shift the burden to the examiner to provide evidence in support of the Official Notice. Allowing such statements to challenge Official Notice would effectively destroy any incentive on the part of the examiner to use it in the processes of establishing a rejection of notoriously well-known facts (*In re Boon*, 169 USPQ 231 (CCPA 1971)).

In conclusion, for the reason set forth above, examiner decides to maintain the previous rejection and make this Office action FINAL.

4. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-3, 6-9, 11, 15-23, 30, 32, 34, 40-42, 45-48, 50, 54-62, 69, 71, 73, 79, and 80 are rejected under 35 U.S.C. 102(e) as being anticipated by Fritsch, U.S. Patent No. 6,247,130.

Regarding to claim 1, Fritsch discloses a server device, comprising:

a first storage unit storing an application divided into a plurality of sub-applications (figure 6 and column 9, lines 18-33, a central server 60 is connected to a database which is a repository of sound files in digital format for downloading to the PC users; figure 4D, the "Louis Armstrong, The Best Of Louis Armstrong" album contains a plurality of tracks);

a receiving unit receiving information from a user (column 4, lines 13-35, the web site vendor receives username and password from the user in order to allow the user access to the web site vendor); and

a sending unit sending at least one of said sub-applications according to said information received (column 6, lines 25-35, the system's digital delivery software module accessing a database for strong digital music, requesting a copy of the purchased items, copying the purchased items from the database and transferring the copies to the consumer to the consumer's PC over the Internet);

at least one of said sub-applications being executable alone (figure 4D, the user can download one track, each track being executable alone), wherein

wherein said first storage unit stores said sub-applications by relating them with IDs for identification thereof; wherein said sub-application includes the ID of the sub-application that is to be utilized next (see figure 2A).

Regarding to claim 2, Fritsch further discloses wherein said sending unit first sends the sub-application that is executable alone (figure 4D, the user can download one track, each track being executable alone).

Regarding to claim 3, Fritsch further discloses wherein said sub-applications have their order for execution, and an object of the application before being divided is achieved by executing said sub-applications in said order (column 3, lines 60-65, the music player may be downloaded to the PC and contains operation controls for listening to the downloaded digital music).

Regarding to claims 6-7, Fritsch further discloses wherein at least one of said sub-application includes the ID that identifies that the relevant sub-application is the last one; wherein when said receiving unit receives the ID of said sub-application, said sending unit sends, based on said ID received, the relevant sub-application stored in

said first storage unit (figure 1A and column 3, lines 50-60, the user may search for desired songs by artist's name, song's title or album name).

Regarding to claims 8-9, Fritsch further discloses a second storage unit storing prescribed information for each said sub-application; wherein said prescribed information includes an ID of said sub-application and price information corresponding thereto (figure 1B and column 4, lines 37-55, the shopping basket can display the name and quantity of the items selected, as well as the cost of each item).

Regarding to claim 11, Fritsch further discloses wherein said prescribed information includes a number of times of utilization of said sub-application (column 7, lines 40-45, how many times the song was purchased).

Regarding to claims 15-16, Fritsch further discloses wherein said prescribed information includes information about presence/absence of advertisement; wherein when the sub-application for which said stored information about presence/absence of advertisement indicates the presence of the advertisement is to be sent, said sending unit sends the relevant sub-application with corresponding advertisement data attached thereto (column 4, lines 57-67).

Regarding to claim 17, Fritsch further discloses wherein said prescribed information includes an application name corresponding to said sub-application (figure 4D, album name and track name).

Regarding to claims 18-21, Fritsch further discloses a third storage unit storing user information; wherein said user information includes user ID and password for

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identification of a user; a first determination unit determining, when said receiving unit receives user ID and password, whether said received user ID and password match the user ID and password stored in said third storage unit; a prohibition unit prohibiting a sending operation of said sending unit when said first determination unit determines that the user IDs and the passwords mismatch. (column 4, lines 13-37).

Regarding to claim 22, Fritsch further discloses wherein said user information includes an application utilization history (figure 2A and column 6, line 50-column 7, line 7).

Regarding to claim 23, Fritsch further discloses an extract unit extracting appropriate advertisement data store; in said first storage unit based on said utilization history stored; and an advertisement data sending unit sending said advertisement data extracted (column 4, lines 57-67).

Regarding to claim 30, Fritsch further discloses a charging unit charging a user a price of said sub-application every time said sending unit sends said sub-application to the user (column 6, lines 20-30).

Regarding to claim 32, Fritsch discloses a server device, comprising:
a first storage unit storing an application divided into a plurality of sub-applications (figure 6 and column 9, lines 18-33, a central server 60 is connected to a database which is a repository of sound files in digital format for downloading to the PC users; figure 4D, the "Louis Armstrong, The Best Of Louis Armstrong" album contains a plurality of tracks);

a receiving unit receiving information from a user (column 4, lines 13-35, the web site vendor receives username and password from the user in order to allow the user access to the web site vendor);

a sending unit sending at least one of said sub-applications according to said information received (column 6, lines 25-35, the system's digital delivery software module accessing a database for strong digital music, requesting a copy of the purchased items, copying the purchased items from the database and transferring the copies to the consumer to the consumer's PC over the Internet); and

a charging unit charging a user a price of said sub-application every time said sending unit sends said sub-application to the user (column 6, lines 20-30, after the list in the shopping basket is finalized, the on-line consumer is requested to pay for the purchase, a charge may be made directly to the on-line consumer's credit card);

wherein said first storage unit stores said sub-applications by relating them with IDs for identification thereof; wherein said sub-application includes the ID of the sub-application that is to be utilized next (see figure 2A).

Regarding to claim 34, Fritsch discloses a second storage unit storing user ID and password for identification of a user; a determination unit determining, when said receiving unit receives user ID and password, whether the received user ID and password match the user ID and password stored in said second storage unit; and a prohibition unit prohibiting a sending operation of said sending unit when said determination unit determines that the user IDs and passwords mismatch (column 4, lines 13-35).

Claims 40-42, 45-48, 50, 54-62, 69, 71, and 73 are written in method and parallel the limitations found in claims 1-3, 6-9, 11, 15-23, 30, 32, and 34 above, therefore, are rejected by the same rationale.

Claims 79 and 80 are written in computer recording medium and parallel the limitations found in claims 1 and 32 above, therefore, are rejected by the same rationale.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 10, 12-14, 31, 33, 49, 51-53, 70, and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fritsch, U.S. Patent No. 6,247,130.

Regarding to claims 10 and 12-14, Fritsch does not disclose wherein said price information corresponding to said sub-application that is being sent in the second or later place is set lower than said price information corresponding to said sub-application that is being sent in the first place; a fifth storage unit storing information of a discount rate corresponding to said number of times of utilization; a setting unit setting a price of the sub-application to be transferred next, based on the number of times of utilization of prescribed said sub-application that is stored in said second storage unit and the discount rate corresponding to the relevant number of times of utilization that is stored

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in said fifth storage unit; a setting unit setting a price of the sub-application to be transferred in the second or later place, based on the number of times of utilization of the sub-application being sent in the first place that is stored in said second storage unit and the discount rate corresponding to the relevant number of times of utilization that is stored in said fifth storage unit. However, those features are well known in the art. For example, a second consumer may get a product or service with lower price than a first consumer because discount rate provided from vendor, a product has a discount rate because the product has the high volume in the inventory. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Fritsch's to adopt the well-known features above, for the purpose of providing incentive to the consumers in order to encourage the consumers to purchase products or services.

Regarding to claims 31 and 33, Fritsch does not disclose a confirmation unit confirming whether sending of said sub-application from said sending unit is completed, wherein said charging unit charges for said sub-application when said confirmation unit confirms completion of the sending. However, providing a confirmation unit confirming whether sending of said sub-application from said sending unit is completed, wherein said charging unit charges for said sub-application when said confirmation unit confirms completion of the sending is well known in the art. For example, a confirming message usually sent to the user to let the user know that the downloading is completed when the user finishes downloading digital content (e.g. music, audio, video, etc.); charging the user after the user receives or downloading digital content. Therefore, it would have

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been obvious to one with ordinary skill in the art at the time the invention was made to modify Fritsch's to incorporate the well-known features above, for the purpose of ensuring the user receives products or services being purchased.

Claims 49, 51-53, 70, and 72 are written in method and parallel the limitations found in claims 10, 12-14, 31, and 33 above, therefore, are rejected by the same rationale.

9. Claims 24-29, 35, 63-68, and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fritsch, U.S. Patent No. 6,247,130, in view of Kupka et al (hereinafter Kupka), U.S. Patent No. 6,434,535.

Regarding to claims 24-29 and 35, Fritsch does not disclose wherein said user information includes credit balance information of a user; a comparison unit comparing said credit balance information of a user and price information of the sub-application required by the user, wherein said sending unit sends said sub-application when said comparison unit determines that said credit balance information is at least equal to said price information; a fourth storage unit storing prepayment information, wherein said prepayment information includes prepaid ID and password; a second determination unit determining, when said receiving unit receives prepaid ID and password, whether said receive; prepaid ID and password match the prepaid ID and password stored in said fourth storage unit; wherein said prepayment information includes value information. However, Kupka discloses wherein said user information includes credit balance information of a user (column 7, lines 48-55, the media 28 includes the prepayment amount for use in purchasing and downloading of electric

content over the network); a comparison unit comparing said credit balance information of a user and price information of the sub-application required by the user, wherein said sending unit sends said sub-application when said comparison unit determines that said credit balance information is at least equal to said price information (column 16, lines 30-50, the media tracking server verifies there is a sufficient balance to cover the cost of the content to be downloaded); a fourth storage unit storing prepayment information, wherein said prepayment information includes prepaid ID and password (column 11, lines 15-30, the media tracking server stores the unique identifier and authentication code of the media 28 in a database); a second determination unit determining, when said receiving unit receives prepaid ID and password, whether said receive prepaid ID and password match the prepaid ID and password stored in said fourth storage unit; wherein said prepayment information includes value information (column 12, line 53-column 13, line 8). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Fritsch's to incorporate the features taught by Kupka above, for the purpose of using pre-paid card to purchase music over the Internet in order to prevent credit card fraud.

Claims 63-68 and 74 are written in method and parallel the limitations found in claims 24-29 and 35 above, therefore, are rejected by the same rationale.

Conclusion

10. Claims 1-3, 6-35, 40-42, 45-74, 79, and 80 are rejected.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (571) 272-6796. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on (571) 272-6799.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-3600.

12. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
C/o Technology Center 3600
Washington, DC 20231

Or faxed to:

(703) 872-9306 (for formal communication intended for entry),

or


(571) 273-0325 (for informal or draft communication, please label "PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Knox building, 501 Dulany Street, Alexandria, VA, First Floor (Receptionist).

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NGA NGUYEN
PRIMARY EXAMINER

January 5, 2007